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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/009,575
Filing Date: August 06, 2002
Appellant(s): LOW ET AL.

John M. Carson (Reg. No. 20,995)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 18, 2008 appealing from the Office
action mailed January 3rd, 2008

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claims 29-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,480,885	Olivier et al.,	11-2002
6,324,569	Ogilvie et al.,	11-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

I. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 29-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 29 is a message processing system which comprises a plurality of means. Such means according to the specification page 2, lines 22-25 are software codes, in which the email manager software uses to process the means as claimed. Such a system as claimed is not part of a computer device, it is therefore a software per-se. It is non-statutory under 35 USC 101.

Claim 30 recites a message processing system. Such a system is not embedded in a physical hardware to perform the elements as claimed.

The use of the word system does not inherently means that the claim is directed to a machine. Only if at least one of the claimed elements of the system is a physical part of a device

and can the system as claimed constitute part of a device or a combination of devices to be a machine within the meaning of 101. A memory or a physical part of a device is not an element of the claimed system. After further review the specification, it is evident that system would suggest to one of ordinary skill that all may be reasonable implement as software routines.

Therefore, the claims 29 and 30 are rejected as a system of software per se, for failing to fall within a statutory category of invention

It is important to note that "Software per se" is non-statutory under 35 USC 101 because it is merely a set of instructions without any defined tangible output or tangible result being produced. The requirement for tangible result under 35 USC 101 is defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998).

Claims 31-35 are rejected for incorporated the deficiency of the base claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 19-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier US Patent no. 6,480,885 and Ogilvie et al., (hereinafter “Ogilvie”) US Patent no.6,324,569.

As to claim 19, Olivier discloses an analogous system that enables users to exchange group electronic mail by establishing profiles and criteria for determining personalized subsets within a group by comparing the identified appearing on the allowed list to determine whether each designated recipient is on the list for the intended recipient that stored on the database of the e-mail manager (col.17, lines 7-12).

In particular, Olivier discloses the claimed “determining if a message is approved for a recipient of the message” (determination is made as to whether the message is approved, see col.14, lines 56-col.15, line 15, emphasis in col.15, line 6); “processing the message for subsequent viewing by the recipient if the message is approved” (col.15, lines 3-15); “storing the message if the message is unapproved” (the message is stored in the email archive table, see col.15, lines 7-8 and col.16, lines 32-33).

Olivier does not explicitly notify the recipient if the message is unapproved.

Ogilvie, on the other hand, discloses an analogous system for “notifying the recipient if a message is unapproved” (as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39). The system of Ogilvie has the capability, both, of requiring that recipients affirmatively remove

unwanted email or create a reply message having remove in the subject to indicate their lack of interest in the subject matter (col.11, lines 1-6) and self removing message indicators from message originators to automatically notify the recipient according to the instruction of the replacement message (col.13, lines 1-5; col.14, lines 14-39).

Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to modify the message distribution system of Olivier by notifying a recipient if a message is unapproved, in the same conventional manner as disclosed by Ogilvie, see col.13, lines 1-5; col.14, lines 14-39). One having ordinary skill in the art would have been motivated to utilize such a modification for the purpose of managing unsolicited email messages without the messages being inadvertently removed by a message filter

As claim 20, Olivier and Ogilvie disclose substantially the invention as claimed. In addition Ogilvie discloses the claimed “allowing the recipient to view an unapproved message” as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39).

As to claim 21, Olivier and Ogilvie disclose substantially the invention as claimed. Olivier, however does not explicitly disclose the claimed notifying the recipient with a notification message having a link to network data representing a list of unapproved.

Ogilvie, on the other hand, discloses the claimed “notifying the recipient with a notification message having a link to network data representing a list of unapproved messages for the recipient” (as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39). The system of Ogilvie has the capability, both, of requiring that recipients affirmatively remove unwanted email or create a reply message having remove in the subject to indicate their lack of interest in the subject matter (col.11, lines 1-6) and self removing message indicators from message originators to automatically notify the recipient according to the instruction of the replacement message (col.13, lines 1-5; col.14, lines 14-39).

Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to modify the message distribution system of Olivier by notifying a recipient if a message is unapproved, in the same conventional manner as disclosed by Ogilvie, see col.13, lines 1-5; col.14, lines 14-39). One having ordinary skill in the art would have been motivated to utilize such a modification for the purpose of managing unsolicited email messages without the messages being inadvertently removed by a message filter

As to claim 22, Since Olivier discloses a web browser plug-ins and other new technology that allow the exchanged messages to be stored somewhere other than the currently viewed web site, retrieve messages from the independent data store and displayed to the user and use an address of a specific page being viewed within the web site (col.25, lines 25-41), the claimed wherein the

network data comprises markup language data accessible by a computer device of the recipient is met.

As to claim 23, Olivier discloses the claimed allowing the recipient to set criteria to determine if the message is approved (col.14, line 55-col.16, line 15; col.17, lines 7-21).

As to claim 24, Olivier discloses the claimed wherein the criteria include a sender of the message being on a stored approved list for the recipient (col.14, line 55-col.16, line 15; col.17, lines 7-21).

As to claim 25, Olivier discloses the claimed allowing the recipient to change the criteria (col.17, line 65-col.18, line 4).

As to claims 26-27, Olivier discloses the claimed notifying a sender of the unapproved message of deletion of the unapproved message (col.14, lines 56-58; col.15, lines 4-14).

As to claim 28, Olivier discloses the claimed wherein the message and the criteria are stored on an electronic message server (col.5, lines 5-45).

As to claim 29, Olivier and Ogilvie substantially disclose the invention as claimed. Ogilvie processes the means as part of the system, see fig. 1, col.3, lines 32-65.

Claims 30-32 are computer system performing by the method of claims 19-28 above. They are, therefore, under the same rationale. In addition, Ogilvie discloses the use of storing and sending a notification to the recipient of unapproved message (col.1, lines 46-53); an access server for generating a display page with a list of unapproved message (col.5, lines 6-45); wherein the list of unapproved messages includes links to the unapproved message respectively and which on selection causes transmission of an unapproved message to a recipient's computer device for viewing by the recipient" (col.1, lines 55-65; col.14, line 26-38).

As to claim 33, Olivier discloses the claimed wherein the criteria include the sender of a message being on an approved list for the recipient stored on the system (col.14, line 55-col.15, line 15).

As to claims 34-35, Olivier discloses the claimed wherein the display page includes a link to at least one display page for displaying and changing the criteria (col.17, line 65-col.18, line 4).

As to claim 36:

Claim 36 is a computer readable storage medium having instructions for executing the method of claim 19 above. It is, therefore, rejected under the same rationale.

(10) Response to Argument

i) The Legal Standard

6. Appellant asserted, page 8, asserted that the Patent and Trademark office ha the burden under the section 103 to establish a prima facie case of obviousness. The examiner disagrees

with the precedent assertion. Appellant appears to misinterpret the guidance given under MPEP 2142. In particular, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In *re* Bozek, 163 USPQ 545 (CCPA) 1969.

MPEP 2143 states:

“To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. In *re* Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

As set forth in the office actions mailed January 3rd, 2008, the suggestion to modify Olivier is suggested by both and knowledge of the ordinary skilled artisan at the time the invention was made. The Court, In *re* Fritch, stated “the examiner can satisfy the above mentioned assertion only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”. In *re* fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (Citing In *re* Lalu, 747, F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988). Specifically, Ogilvie teaches that it was desirable to transmit confidential information to a party if consent for publication is affirmatively given. Additionally, the ordinary skilled artisan, as well

as those of less than ordinary skill in the art, would have recognized the advantages of enabling use of self-removing e-mail to enhance security of system by reducing the number of message copies, and the life span of the message copies and reducing the inconvenience of unsolicited e-mail by making it possible for officials, advertisers, and other broadcast e-mail originators to present messages that do not have to be manually removed by the target audience. Moreover, the issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1596, 1598 (Fed. Cir. 1988) (Citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al.*, 192 USPQ 278 (CCPA) that:

- (a) Obviousness does not require absolute predictability;
- (b) Non-preferred embodiments of prior art must also be considered; and
- (c) The question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement, that which is disclosed therein.

Hence, the Patent and Trademark Office has clearly established the first criteria of the *prima facie* case of obviousness.

Secondly, the examiner has established that there is a reasonable expectation of success of the Olivier/Ogilvie combination. In the last office action, the examiner went through the

claims phrase by phrase and referred to the prior art column and line number as to where he has drawn the correspondences between appellant' claims phrases and prior art. Both Olivier and Ogilvie are directed to email distribution. As to indicate in the January 3rd, 2008 Final office action, Olivier discloses all of the claimed subject matter except for the use of notifying the recipient if a message is unapproved. The Ogilvie system and method is based on sending notification acknowledgement when a message is unapproved. Hence, clearly the systems are compatible and would render a combination system successful.

Finally, as set forth in the final office action, the suggestion to make the claimed combination and the reasonable expectation of success are both found in Olivier and Ogilvie.

Therefore, the combination of the Olivier and Ogilvie is proper and the rejection is hereby sustained.

ii) Neither Olivier nor Ogilvie teaches or suggests the features of each of pending claims 19-36.

7. Appellant respectfully submits that neither Olivier nor Ogilvie teaches the feature of notifying the recipient and storing the message if the message is unapproved. The examiner respectfully disagrees with the precedent assertion. The examiner's position with respect to the assertion above is that Olivier discloses an analogous system that enables users to exchange group electronic mail by establishing profiles and criteria for determining personalized subsets within a group by comparing the identified appearing on the allowed list to determine whether each designated recipient is on the list for the intended recipient that stored on the database of the e-mail manager (col.17, lines 7-12). In particular, Olivier discloses the claimed "determining if a

message is approved for a recipient of the message” (determination is made as to whether the message is approved, see col.14, lines 56-col.15, line 15, emphasis in col.15, line 6); “processing the message for subsequent viewing by the recipient if the message is approved” (col.15, lines 3-15); “storing the message if the message is unapproved” (the message is stored in the email archive table, see col.15, lines 7-8 and col.16, lines 32-33).

Ogilvie, on the other hand, discloses an email verification system for notifying the recipient if message is approved (col.14, lines 26-39). The system disclosed by Ogilvie checks the incoming messages to determine whether they contains a self-removing messaging indicator from the message originator or message distributors and automatically notifies the recipient. Similarly to the appellant’s disclosure, where the e-mail message is based on whether a sender of a message is on a list of approved senders for the intended recipient that is stored on the database of the e-mail manager. Indeed, the removal code of Ogilvie determines whether the incoming messages contain any self-removing message indicators from message originators and/or message distributors (so called intended recipient list). Ogilvie further states that the check triggering criteria is used by the intended recipient list to allow the option to block the email or send the recipient a notification request, see col.13, lines 62-col.14, line 12). Therefore, the combination of Olivier and Ogilvie arrive to the subject matter as claimed, specifically the use of notifying the recipient if a message is unapproved.

iii). The parent applications of Ogilvie which antedate the priority date of this application (May 12, 1999).

8. Appellant, pages 10-11, asserted that none of the showing of Ogilvie to support the

claimed limitation "notifying recipient if a message is unapproved" were disclosed in the parent applications which antedate the priority date of this application (May 12, 1999), and the cited passage does not teach or suggest the above indicated feature of the claimed invention. The examiner disagrees with the precedent assertion. Appellant should duly note that the provisional application no. 60/14,138 filed on October 14, 1998 stated that any reply to some unsolicited email would simply confirm that the address to which the unsolicited mail was sent is "good" and that a reply asking to be removed from the mailing list may therefore have the opposite effect, in that addresses from which no reply is received are eventually removed from the list. The self-removing email file's self-removal property as disclosed by the provisional application no. 60/14,138 can be expressly overridden by the sender, by the recipient, by an intervening authority such as an ISP or an authorized government agency, or by some combination of these. So the possibility of a reply is an explicit option presented to the user allowing the user to request removal as it was notify as whether the message is approved or unapproved (page 4, lines 5-15). On the other hand, the provisional Application no. 60/101,517 filed on September 23, 1998, stated that the email message does not initially delete itself after displaying the message. Instead, allowing the email message to be modified based on the notification request by the recipient (page 10, lines 1-2; and page 12, lines 1-4). It is indeed that Ogilvie discloses an email verification system for notifying the recipient if message is approved (col.14, lines 26-39). The system disclosed by Ogilvie checks the incoming messages to determine whether they contains a self-removing messaging indicator from the message originator or message distributors and automatically notifies the recipient. Similarly to the appellant's disclosure, where the e-mail message is based on whether a sender of a message is on a list of approved senders for the

intended recipient that is stored on the database of the e-mail manager. Indeed, the removal code of Ogilvie determines whether the incoming messages contain any self-removing message indicators from message originators and/or message distributors (so called intended recipient list). Ogilvie further states that the check triggering criteria is used by the intended recipient list to allow the option to block the email or send the recipient a notification request, see col.13, lines 62-col.14, line 12).

Therefore, the limitation that Applicant is relied upon is well supported by the provisional applications as stated above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other

evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Jean M. Corrielus/
Primary Examiner, AU 2162

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/ANDREW H HIRSHFELD/
Director, TC 2100

Conferees:

Trujillo James, SPE 2169

/James K. Trujillo/

Supervisory Patent Examiner, Art Unit 2169

For: Alam Shahid, Primary Examiner 2162

/Pierre M. Vital/
Supervisory Patent Examiner, Art Unit 2169